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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,023	05/01/2001	Tatsuya Haraguchi	016907/1229	4290
22428	7590	07/27/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/846,023	<b>Applicant(s)</b> HARAGUCHI ET AL.	
	<b>Examiner</b> Namrata Boveja	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/1/01 &amp; 2/5/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-7 were elected by the applicant in response to the restriction notice sent on 04/10/2006 and are presented for examination.

### ***Objections***

2. Applicant needs to submit a new listing of the claims showing that claims 8-16 have been cancelled and should indicate this in parenthesis next to each claim that is original, new, or cancelled. See 37 CFR 1.121.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 4 recites displaying advertisements "in a time-division manner," and this "time-division manner" is not adequately described in the specification with the exception on page 23. Appropriate correction is required. It is interpreted to mean that "time-division manner" means that the displayed advertisements are rotated with other advertisements after a time period.

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

4. Claims 1, 2, and 4 are rejected under 35 U.S.C. 112 second paragraph.

Claim 1 recites an advertisement display means composed of a plurality of display means. It is unclear what this means, since it is unclear if there one display means, i.e. a computer monitor, or if there are various monitors.

5. Claim 2 recites a plurality of liquid crystal displays. It is unclear if this means multiple computer monitors or just one monitor that can have different displays.

6. Claim 4 recites "a time-division manner." It is unclear what the applicant means by "a time-division manner," since this was not defined in the previous claims and was not adequately described in the specification.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 are rejected under 102(b) as being anticipated by Matthias  
(Publication Number WO 99/05630 hereinafter Matthias).

**Disclaimer:** Claim 1 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was

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applied.

In reference to claim 1, Matthias teaches an advertisement information processing system for processing advertisement information relating to various commodities, comprising: storage means for storing, in a mutually associated manner, display information and print information on the advertisement information relating to various commodities (page 1 lines 15-28, page 2 lines 8-14 and 24-31); advertisement display means, composed of a plurality of display means (i.e. each cell is a display means), for displaying the display information stored in the storage means (page 1 lines 22-26, page 1 lines 29-page 2 lines 7, page 3 lines 28 to page 4 lines 5, page 4 lines 31 to page 5 lines 11, page 5 lines 25 to page 6 lines 4, page 6 lines 27-30, and Figures 1 and 3); display control means for effecting a control to display one or more display information items stored in the storage means on said plurality of display means constituting the advertisement display means (page 1 lines 29 to page 2 lines 7, page 3 lines 28 to page 4 lines 11, page 5 lines 7 to page 6 lines 4, and Figure 3); a plurality of instruction means, provided in association with the plural display means constituting the advertisement display means, for individually instructing printing of the display information displayed on the display means (i.e. when the user touches the cell with the particular product of interest, the coupon dispenser prints it instantly) (page 5 lines 1-6); print control means for effecting, when printing is instructed by any one of the plural instruction means, a control to read out the print information and print out the print information, which corresponds to the display information displayed on the display means associated with the instruction means (i.e. when a coupon printing signal is

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received, the coupon is generated and printed) (page 2 lines 15-23); and print means for printing the print information controlled by the print control means (page 4 lines 11-19 and lines 28-29 and Figure 2).

8. **Disclaimer:** Claim 2 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 2, Matthias teaches an advertisement information providing system according to claim wherein said advertisement display means is a display composed of a plurality of liquid crystal displays (i.e. multiple cells with displayed information can be treated as a plurality of liquid crystal displays) or CRT displays provided on a wall surface in an office (i.e. a retail store can be treated as an office, since it is also a place where clients are coming in and interacting with the display) (page 3 lines 30 to page 4 lines 5 to page 5 lines 24 and Figure 3).

9. In reference to claim 3, Matthias teaches an information providing system wherein said display control means effects a control to display one or more display information items stored in the storage means on the plurality of display means constituting the advertisement display means according to preset rules (i.e. page 1 lines 29 to page 2 lines 6, and page 6 lines 15-30).

10. **Disclaimer:** Claim 4 was found to be deficient under U.S.C. 112 first and second paragraphs. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 4, Matthias teaches an advertisement information providing system according to claim wherein said display control means effects a control to display one or more display information items stored in the storage means on the plurality of display means constituting the advertisement display means in a time-division manner (i.e. advertisements can be rotated after a given time period) (page 2 lines 3-5 and page 6 lines 25-30).

11. In reference to claim 5, Matthias teaches an advertisement information providing system wherein display control means effect a control to display the display information stored in the storage means by varying display rules such as positions of the display means used for display (page 1 lines 30 to page 2 lines 2), time slots, time lengths (page 2 lines 3-5 and page 6 lines 25-30), and the number of times, in accordance with characteristics of the commodity (i.e. specific items can be offered for sale during a promotion and their locations can be identified on the coupon) (page 5 lines 28-32 and page 6 lines 15-20).

12. In reference to claim 6, Matthias teaches an advertisement information providing system wherein said display control means effects a control to display the display information stored in the storage means by varying display rules, such as positions of the display means used for display (page 1 lines 30 to page 2 lines 2), time slots, time lengths (page 2 lines 3-5 and page 6 lines 25-30), and the number of times, in accordance with a print history controlled by the print control means (page 6 lines 31 to page 7 lines 7).

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13. In reference to claim 7, Matthias teaches an advertisement information providing system wherein said print means is a printer (page 4 lines 11-19 and 28-29 and Figure 2).

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

July 20<sup>th</sup>, 2006



**RAQUEL ALVAREZ  
PRIMARY EXAMINER**

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